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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,711	07/08/2003	Yeong-Seop Lee	5000-1-291	9441

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CHA & REITER, LLC
210 ROUTE 4 EAST STE 103
PARAMUS, NJ 07652

EXAMINER	
HOFFMANN, JOHN M	

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/615,711	LEE ET AL.	
	Examiner	Art Unit	
	John Hoffmann	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 July 2006*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner could find no support for the newly claimed requirement that the operation is based on a speed of the fiber – either explicit or implicit. This is deemed to be a prima facie showing on failure to comply with the requirement. The burden is now on Applicant to show the requirement is complied with, or to amend the claims so that they comply.

The description fails to reasonably convey the inventions of new claims 15, 16, 18 and 20. Examiner could not find the inventions – in particular the specific functionality - of each claim.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 8, 10-12 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden 4966615 in view of Sapsford 5568728 and/or the prior art

admission (hereinafter referred to as PAA) as per the changes to page 7 of the specification.

See the prior Office actions for the manner in which Linden and Sapsford are combined. (In summary – It would have been obvious to be able to open the Linden cooler as taught by Sapsford, for the advantage of Sapsford – i.e. to facilitate fiber threading.)

The PAA states that the means for automatically opening, closing and controlling is a known function or configuration – see also page 12 of the 19 July 2006 response which indicates the same thing.

Thus one would have been motivated to apply the known means discussed in the PAA to the Linden apparatus, for the function that the known means performs.

III. AUTOMATING A MANUAL ACTIVITY
In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

It is noted, even without the PAA, it would have been obvious to provide structure to automatically open the hinged chamber – as indicated in In re Venner (above). Claim 1 requires more than mere automation. Rather it requires it to be "based on a current drawing speed". Whereas this would encompass having a sensor which can measure the draw speed, and then adjust the opening based on the measurement, the claim is not limited to this. It would be improper for the Office to read such a limitation into the

claim – where it clearly does not exist. Rather, the claim is deemed to include such things as keeping the device closed when the draw speed is adequate, and opening it when it is not. The plain teaching of Sapsford is that the device is opening when one first starts the drawing process, and then closes it when the fiber is being drawn. Thus the opening/closing would be loosely "based on" the speed of the fiber.

As indicated elsewhere in this action, Examiner could not find a description of the controlling based on the speed. Thus Examiner cannot justify interpreting the claims any narrower than this. Moreover, claim 20 suggests that the "based on" is directed to merely whether the speed is zero or non-zero.

Sapsford is deemed not necessary in the rejection. Since the PAA indicates that the function of opening a cooling chamber is known, it would have been obvious to apply the known function to the Linden chamber.

New claim 14: Linden has the cap. Claim 15: it is deemed that the generator works automatically based on when the fiber and/or gas move fast enough to cause turbulence.

For claims 16-20 – each claim clearly reads on the above broadest reasonable interpretation.

Claim 16 invokes 35 USC 112 – 6th paragraph. It is deemed that the claims covers the same thing that is admitted by the PAA – and thus any detailed analysis under the 6th paragraph is deemed superfluous.

Claims 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden 4966615 in view of Sapsford 5568728 and/or the PAA as applied to claim 1 above, and further in view of Hisashi (jp6219789).

See the prior Office actions for the manner in which Hisashi is applied to the other references.

Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden 4966615 in view of Sapsford 5568728 and/or the PAA as applied to claim 1 above, and further in view of Ghani (2003/0205066)

See the prior Office actions for the manner in which Ghani is applied to the other references.

Response to Arguments

Applicant's arguments filed 24 July 2006 have been fully considered but they are not persuasive.

It is argued that Sapsford is different from the present invention because Sapsford opening is merely to facilitate threading of optical fiber, but the present invention is for automatically operating the cooling body based on a current draw speed. This is not convincing for the reasons put forth in the above rejections: 1) It appears that Applicant's original disclosure does not teach automatic operation based on drawing speed, 2) Applicant admits such control/configuration is already known, and 3) It would have been obvious to make the Sapsford opening/closing automatic.

The rest of the arguments are moot due the amendments- or else are directed to the dependent claims, but rely on the same argument – that the combination lacks the claimed automatic control.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Hoffmann
Primary Examiner
Art Unit 1731

9-5-06

jmh